

REMARKS

Claims 1, 3-5, 7, 9, 11, 15, 17 and 20 are pending in the application. Claim 2 was previously canceled, claim 1 was amended and claim 20 has been added by way of the present amendment. Favorable reconsideration of the application is requested.

In the outstanding Office Action, issued April 10, 2006, claims 1, 3-5, 7, 9, 11, 15 and 17 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Publication No. 2001/0051987 (Fukumoto et al.) in view of U.S. Patent No. 6,301,608 (Rochkind).

U.S.C. Section 103 Rejections

Claims 1, 3-5, 7, 9, 11, 15 and 17 were rejected under 35 U.S.C. 103(a) as being unpatentable over Fukumoto et al. in view of Rochkind. Applicants respectfully traverse the rejection.

Applicants respectfully submit that to establish a *prima facie* case of obviousness, three basic criteria must be met: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; (2) there must be a reasonable expectation of success; and (3) the prior art reference must teach or suggest all the claim limitations.¹ Further, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not just within the applicant's disclosure.²

Combining prior art references without evidence of a suggestion, teaching or motivation simply takes the inventors' disclosure as a blueprint for piecing together the prior art to defeat patentability – the essence of hindsight.³

¹ See MPEP §2143.

² *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) and See MPEP §2143.

³ *Interconnect Planning Corp. v. Feil*, 227 USPQ 543 (Fed. Cir. 1985)

“There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art.”⁴ Further with regard to the level of skill of practitioners in the art, there is nothing in the statutes or the case law which makes “that which is within the capabilities of one skilled in the art” synonymous with obviousness.⁵ The level of skill in the art cannot be relied upon to provide the suggestion to combine references.⁶

Fukumoto et al. discloses an E-mail system and E-mail transmission method of broadcasting where, when transmitting a broadcasting E-mail, a sender designates a transmission destination of an emphasized part for each item.⁷ In particular, Fukumoto et al. discloses the transmitting client **11** instructs the mail server **12** to *transmit to each receiver* the E-mail that is prepared by *emphasizing and highlighting a transmission document* for each receiver.⁸

Further, Fukumoto et al. discloses *the mail server 12 allocates the transmission documents to the respective destinations, emphasizes and highlights the related part for each destination*, and stores the documents in the mailbox **14** of the mail server **12** (emphasis added).⁹ Furthermore, Fukumoto et al. discloses *the transmission document is transmitted to the receiving client 13 corresponding to the destination* (emphasis added).¹⁰ Moreover, Fukumoto et al. discloses the screen of each receiving client **13**, the part related to the receiver in the transmission document is emphasized and displayed with a designated highlighting method.¹¹

However, Fukumoto et al. nowhere discloses, as recited in claim 1:

appending to each of said addresses a tag representing an attention level for said recipients and a tag identifying said specific highlighted portion for each recipient.

⁴ See MPEP §2143.01, citing *In re Rouffet*, 149 F.3d, 1350, 1357, 47 USPQ2d 1453, 1457-8 (Fed. Cir. 1998).

⁵ *Ex parte Gerlach and Woerner*, 212 USPQ 471 (PTO Bd. App. 1980).

⁶ See MPEP §2143.01, citing *At-Site Corp. v. VSI Int'l Inc.*, 50 USPQ2d 1161 (Fed. Cir. 1999).

⁷ Fukumoto et al. at ABSTRACT.

⁸ *Id.* at FIG. 2; and page 2, paragraph 47, lines 4-7.

⁹ *Id.* at FIG. 2; and page 2, paragraph 48, lines 1-4.

¹⁰ *Id.* at FIG. 2; and page 2, paragraph 48, lines 4-6.

¹¹ *Id.* at FIG. 2; and page 2, paragraph 48, lines 6-9.

That is, Fukumoto et al. does not disclose both “a tag representing an attention level” and “a tag identifying said specific highlighted portion,” as recited in claim 1. Therefore, it is respectfully submitted that Fukumoto et al. does not disclose the claimed invention.

In addition, it is respectfully submitted that Fukumoto et al. nowhere discloses “determining from a tag inserted in an address field of said message whether any portion of said message is highlighted,” as recited in claim 9, “displaying on said computer terminal a pop-up table which identifies various attention levels which may be assigned to each addressee,” as recited in claims 11 and 15; and “determining from a tag inserted in a field of said message whether any portion of said message is highlighted,” as recited in claim 17. In view of the above, Applicants submit that there is clearly no teaching in Fukumoto et al. directed at identifying a “specific highlighted portion for each recipient,” as recited in the of the invention. Therefore, it is respectfully submitted that Fukumoto et al. does not disclose the claimed invention.

In addition, the outstanding Office Action acknowledges deficiencies in Fukumoto et al. and attempts to overcome these deficiencies with Rochkind.¹² However, as discussed above, if Fukumoto et al. is to be combined with Rochkind the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not just within the applicant’s disclosure.¹³

Rochkind discloses a method and apparatus that provides personalized mailbox filters where the electronic mailbox filters or sorts messages according to personalized or customized rules set by the owner of the mailbox through the use of address extensions.¹⁴ In particular, Rochkind discloses predetermined address extensions and their corresponding message tags

¹² Outstanding Office Action, paragraphs 11, 17 and 19.

¹³ *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) and *See* MPEP §2143.

¹⁴ Rochkind at ABSTRACT.

which indicate message play back priority.¹⁵ Further Rochkind discloses a system that could specify default message tags, such as urgent, important, normal, etc.¹⁶

However, as the outstanding Office Action acknowledges by attempting to make the combination, Rochkind does not disclose “a tag identifying said specific highlighted portion,” as recited in claim 1. It is respectfully submitted, that the outstanding Office Action makes the general allegation that there is motivation to combine Fukumoto et al and Rochkind:

because correlating a specific recipient’s address with a section of a email message to be highlighted for their specific attention will give a specific recipient the ability to pay attention and identify at a glance, the important parts of the e-mail that pertain to that specific recipient.¹⁷

Applicants respectfully submit that *neither the teaching or suggestion to make the claimed combination are found in the prior art*. It is respectfully requested that such a citation from the prior art identifying such a teaching or suggestion be made if the rejection is to be maintained.

Moreover, as discussed above, combining prior art references without evidence of a suggestion, teaching or motivation simply takes the inventors’ disclosure as a blueprint for piecing together the prior art to defeat patentability – the essence of hindsight.¹⁸ Clearly, neither Fukumoto et al. nor Rochkind disclose both “a tag representing an attention level” and “a tag identifying said specific highlighted portion,” as recited in claim 1. Only, applicant’s disclosure suggests such a combination. Thus, Applicants respectfully submit that the combination is just within the applicant’s disclosure and the motivation to the combine the two is clearly hindsight and thus improper.¹⁹ Thus, Rochkind cannot overcome the deficiencies of Fukumoto et al.

Therefore, it is respectfully submitted that neither Fukumoto et al. nor Rochkind, whether taken alone or in combination, do not disclose, suggest or make obvious the claimed invention

¹⁵ *Id.* at column 6, lines 9-11.

¹⁶ *Id.* at column 6, lines 36-37.

¹⁷ Outstanding Office Action, page 4, paragraph 12, lines 7-11.

¹⁸ *Interconnect Planning Corp. v. Feil*, 227 USPQ 543 (Fed. Cir. 1985)

¹⁹ *In re Vaecck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) and *See* MPEP §2143.

and thus, claims 1, 9, 11, 15 and 17, and claims dependent thereon, patentably distinguish thereover.

New Claim

New claim 20 has been added by way of the present amendment to further clarify the invention. In particular, claim 20 is an amended version of claim 1. Claim 20 in part recites the following:

appending to each of said addresses a *tag1* representing an attention level for said recipients and a *tag2* identifying said specific highlighted portion;
sending said text message to each of said recipients which includes each of said addresses and the appended *tag1* and *tag2*;
displaying for each recipient said text message with an attention level indication in response to the *tag1* associated with the recipients address; and
decoding *tag2* with said specific portion highlighted for said recipient having said specific address,
wherein the displaying and the decoding are executed on electronic mail terminals of the recipients (emphasis added).

Support for the new claim is provided at least at paragraph [0038], lines 1-3 and 15-20; and shown at least in FIG. 3. Therefore the new claim raises no question of new matter.

It is respectfully submitted that, at least for the reasons above, claim 1 patentably distinguishes over both Fukumoto et al. and Rochkind. In addition, as discussed above, Fukumoto et al. discloses the transmitting client **11** instructs the mail server **12** to *transmit to each receiver* the E-mail that is prepared by *emphasizing and highlighting a transmission document* for each receiver.²⁰ Further, Fukumoto et al. discloses *the mail server 12 allocates the transmission documents to the respective destinations, emphasizes and highlights the related part for each destination*, and stores the documents in the mailbox **14** of the mail server **12**

²⁰ *Id.* at FIG. 2; and page 2, paragraph 47, lines 4-7.

(emphasis added).²¹ Furthermore, Fukumoto et al. discloses *the transmission document is transmitted to the receiving client 13 corresponding to the destination* (emphasis added).²² Thus, Fukumoto et al. nowhere discloses, as claim 21 recites: “wherein the displaying and the decoding *are executed on electronic mail terminals of the recipients*” (emphasis). That is, in contrast to claim 20, Fukumoto et al. discloses highlighting at the mail server **12** before transmitting to receiving clients **13**.

In addition, Rochkind cannot overcome the deficiencies of Fukumoto et al. since it nowhere discloses “displaying and the decoding *are executed on electronic mail terminals of the recipients*” (emphasis added). Therefore, it is respectfully submitted that neither Fukumoto et al nor Rochkind disclose, suggest or make obvious the claimed invention and that claim 20, patentably distinguish thereover.

Conclusions

In view of the foregoing, favorable reconsideration is believed to be in order. If a fee is due, please charge our Deposit Account No. 09-0458, under Order No. 20136-00324-US from which the undersigned is authorized to draw.

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Respectfully submitted,

By /Myron Keith Wyche/
Myron Keith Wyche, Reg. No. 47,341
CONNOLLY BOVE LODGE & HUTZ LLP
1990 M Street, N.W., Suite 800
Washington, DC 20036-3425
(202) 331-7111
(202) 293-6229 (Fax)
Agent for Applicant

²¹ *Id.* at FIG. 2; and page 2, paragraph 48, lines 1-4.

²² *Id.* at FIG. 2; and page 2, paragraph 48, lines 4-6.